

*AP/CP-1645*

Docket No. 41426-D/JPW/SHS

In re application of Ron S. Israeli, et al.

Serial No.: **JUN 17 1999** 08/470,735 Group Art Unit: 1645

Filed: June 6, 1995 Examiner: S. Gucker

For: PROSTATE-SPECIFIC MEMBRANE ANTIGEN AND USES THEREOF

HONORABLE ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

June 14, 1999

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S I R:

Transmitted herewith is an amendment to the above-identified application.

X Small entity status of this application under 37 C.F.R. § 1.9 and § 1.27 has been established by a verified statement previously submitted.

       a verified statement to establish small entity status under 37 C.F.R. § 1.9 and § 1.27 is enclosed.

X No additional fee is required.

The filing fee is calculated as follows:

	NUMBER AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		NUMBER OF EXTRA CLAIMS PRESENTED		RATE		FEE	
							SMALL ENTITY	OTHER ENTITY	SMALL ENTITY	OTHER ENTITY
Total Claims	16	-	* 105	=	*** 0	x	9	18	=	0
Independent Claims	4	-	** 7	=	*** 0	x	39	78	=	0
Multiple Dependent Claims(s) Presented <u>      </u> Yes <u>X</u> No							130	260		0
For First Time:							TOTAL ADDITIONAL \$			
							FEE			
							0			

\*If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 20, write "20" in this space.

\*\*If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 3, write "3" in this space.

\*\*\*If the difference between the "NUMBER AFTER AMENDMENT" and the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than "0", write "0" in the space.

Applicants: Ron S. Israeli, et al.  
Serial No.: 08/481,916  
Filed: June 7, 1995

Amendment Transmittal Letter  
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The "HIGHEST NUMBER PREVIOUSLY PAID FOR" (Total Independent) is the highest of the "NUMBER AFTER AMENDMENT" in any prior amendment or the number of claims as originally filed.

\_\_\_\_ Please charge Deposit Account No. \_\_\_\_\_  
in the amount of \$\_\_\_\_\_.

  X   A check in the amount of \$ 1,305.00 is enclosed.

  X   The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 03-3125. Three copies of this sheet are enclosed.

  X   Any filing fees under 37 C.F.R. §1.16 for the presentation of extra claims.

  X   Any patent application processing fees under 37 C.F.R. §1.17.

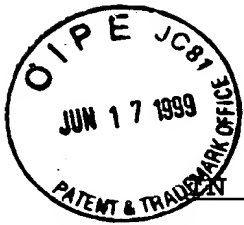
Respectfully submitted,

Albert Wai Kit Chan

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Albert Wai Kit Chan 6/14/99  
Albert Wai-Kit Chan Date  
Reg. No. 36,479

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Dkt. 41426-D/JPW/SHS

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ron S. Israeli et al.

Serial No.: 08/470,735

Group Art Unit: 1645

Filed : June 6, 1995

Examiner: S Gucker

For : PROSTATE-SPECIFIC MEMBRANE ANTIGEN AND USES THEREOF

1185 Avenue of the Americas  
New York, New York 10036  
June 14, 1999

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Box: AF

Sir:

**COMMUNICATION REQUESTING CONSIDERATION ON  
THE MERITS OF A FIRST SUBMISSION AFTER FINAL  
REJECTION AND WITHDRAWAL OF FINALITY UNDER 37 C.F.R.  
§1.129(a) AND PETITION FOR A FIVE MONTH EXTENSION OF TIME**

This Communication is submitted pursuant to the provisions of 37 C.F.R. §1.129(a) to request consideration on the merits of a Supplemental Amendment in Response to May 12, 1998 Final Office Action as a First Submission, attached hereto as Exhibit A, and withdrawal of finality of the May 12, 1998 Final Office Action.

On May 12, 1998, the United States Patent and Trademark Office issued a Final Office Action in connection with the above-identified application. A response to the May 12, 1998 Final Office Action was originally due on August 12, 1998. Applicants filed An Amendment in Response to the May 12, 1998 Final Office Action and a Petition for a Three Month Extension of Time on November 12, 1998. A Notice of Appeal was filed on November 12, 1998 and an appeal brief was due on January 12, 1998. Applicants hereby request a five-month extension of time. Therefore, a response was due June 12, 1999. Since June 12, 1999 is a Saturday, in accordance with 37 C.F.R. 1.7, a response is due on the next succeeding day which is not a Saturday, Sunday or Federal Holiday, i.e. Monday June 14, 1999. Applicants have previously established small-entity status. The fee for a five-

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02 FC:246

925.00 OP  
380.00 OP

#17 6/23/99  
T. Gray

Applicants: Ron S. Israeli et al.  
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month of extension of time is \$925.00 and under 37 C.F.R. §1.17(r) the fee for filing a submission after final rejection is \$380.00. Applicants enclose a check in the amount of \$1305.00 to cover these fees. Accordingly, the subject application is pending. Therefore, the Supplemental Amendment in Response to May 12, 1998 Final Office Action as a First Submission, attached hereto as Exhibit A, is now due June 14, 1999 and is being timely filed.

Under 37 C.F.R. §1.129(a), applicants in an application that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365 (c), are entitled to have a First Submission entered and considered on the merits after final rejection if the First Submission and the fee set forth in §1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application.

For its earliest priority date, the subject application claims priority of 07/973,337 filed November 5, 1992. Therefore, taking into account this priority reference this application has been pending for at least two years as of June 8, 1995. This Communication is prior to the filing of an Appeal Brief and prior to abandonment of the subject application. Accordingly, the First Submission in Response to the May 12, 1998 Final Office Action under 37 C.F.R. §1.129(a) is being timely filed.

The fee under 37 C.F.R. §1.17(r) for consideration and entry of a first submission after a final rejection is \$380.00. As stated hereinabove, applicants enclose herewith a check which includes this fee.

Under 37 C.F.R. §1.129(a), the finality of the final rejection is automatically withdrawn upon the timely filing of the First Submission and the payment of the fee set forth in §1.17(r).

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Accordingly, applicants respectfully request that the finality of the May 12, 1998 Final Office Action be withdrawn and the Supplemental Amendment in Response to May 12, 1998 Final Office Action as a First Submission, attached hereto as Exhibit A, be considered as the First Submission.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants's undersigned attorney invites the Examiner to telephone at the number provided below.

No fee, other than the \$925.00 fee for a five month extension of time and the \$380.00 fee under 37 C.F.R. §1.17(r) are deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Albert Wai-Kit Chan

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Albert Wai-Kit Chan

Albert Wai-Kit Chan  
Reg. No. 36,479

6/14/99  
Date

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